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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,653	06/26/2000	Yong Zou	8737-000007	8304

7590 08/02/2002
Harness Dickey & Pierce
PO Box 828
Bloomfield Hills, MI 48303

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 08/02/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary

Application No.

09/529,653

Applicant(s)

ZOU ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2002.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-18 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1731

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-25-02 has been entered.

Claim Objections

2. Claim 13 is objected to because of the following informality: In line 1, Applicant has claimed a "cigarette" when the claim from which it depends is drawn to a "cigar". The Examiner assumes that Applicant intends to claim "a cigar", and the claims have been examined based this assumption. If the Examiner's assumption is correct, it is requested that Applicant change "cigarette" to --cigar--. Otherwise, it is suggested that the claim be cancelled. Appropriate correction is requested.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 14-15 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 8266261.

Art Unit: 1731

JP 8266261 discloses a cigarette having a main body and a filter attached integrally to an end of the main body, said filter comprising dried and crushed ginkgo leaves (See English abstract). By providing a cigarette filter formed of ginkgo leaves, a cigarette comprising a burnable material is obviously provided because the "filter" is a part of the cigarette of JP 8266261, and ginkgo leaves are obviously "burnable", since it is a plant material and since almost any material is "burnable" if subjected to high enough temperatures. Therefore, ginkgo leaves as used in the filter of the cigarette of JP 8266261 qualifies as "burnable material". Further, since "ginkgo leaves" qualifies as such a burnable material, the step of smoking a cigarette comprising leaves of ginkgo biloba, as recited in claims 14-15, has also been satisfied.

5. Claims 4-5, 9-10, and 14-16 rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1140036 (Abstract).

CN 1140036 discloses a toxicity-reduced cigarette that contains liquid having components of ginkgo leaf sprayed onto the smokable material of the cigarette (see English abstract). While CN 1140036 (Abstract) may not state that the ginkgo leaves are burnable material or burn during smoking, it follows that the ginkgo leaves burn while smoking since said leaves are sprayed onto the material that is smoked/burned while the cigarette is in use.

Regarding claims 9 and 10, while CN 1140036 may not state that the smokable material of its invention may be suitable for use in a cigar, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the ginkgo-leaves-sprayed material for such purpose in order to reduce the damage of nicotine that also

would arise from smoking a cigar which, as is well-known, also comprises tobacco which would contain nicotine when smoked by a user.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (US. Pat. No. 3,369,552) in view of Applicant's Admitted Prior Art.

Carroll discloses a tobacco substitute produced from the leaves of non-tobacco vegetation (corresponding to the claimed "burnable material"), which is acceptable as the smokable material of cigarettes or cigars (see cols. 1-4). While Carroll may not specifically disclose ginkgo leaves as the burnable material for its tobacco substitute, it does disclose that the substitute of its invention can be formed from leafy non-tobacco plants. Further, Applicant admits that the ginkgo biloba tree is the oldest tree in the world (see instant specification page 2), and that the leaves of such trees have proven to have positive effects on health (page 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to employ ginkgo leaves as the base for the tobacco substitute of Carroll because the ginkgo tree is a non-tobacco plant, which has been known for centuries, and said plant has leaves, which contain components that are known to provide beneficial health advantage – both of which are attributes consistent with the teaching of Carroll et al, the goal of which patent is to provided a product derived from non-tobacco, leafy plants.

Because there is no indication, in Carroll, that the "burnable material" would comprise anything other than one species of non-tobacco leafy vegetation (as opposed to a blend of several types of plant leaves), it follows that said material of Carroll modified by Applicant's Admitted Prior Art would be 100% ginkgo biloba leaves.

Response to Arguments

8. Applicant's arguments with respect to the Buchmann et al reference regarding the pending claims have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments with respect to the JP 8266261 reference have been fully considered but they are not persuasive. The Examiner believes that the arguments with respect to the JP reference have been adequately addressed in the above rejection (see paragraphs 3-4). Further, it is noted that the feature upon which Applicant relies (i.e., "burning portion of the cigarette or cigar") is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

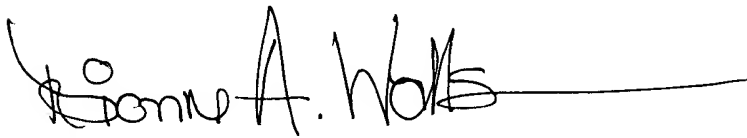
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

Art Unit: 1731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", followed by a long horizontal line extending to the right.

Dionne A. Walls
July 29, 2002